

512



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/336,200	06/18/1999	SIMON H. CORSTON-OLIVER	M61.12-0099	7359

7590 02/12/2002

JOSEPH R KELLY  
WESTMAN CHAMPLIN & KELLY P A  
900 SECOND AVENUE SOUTH  
MINNEAPOLIS, MN 554023319

EXAMINER

PARDO, THUY N

ART UNIT	PAPER NUMBER
----------	--------------

2171

DATE MAILED: 02/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

12

**Office Action Summary**

Application No.  
**09/336,200**

Applicant(s)  
**Corston-Oliver**

Examiner  
**Thuy Pardo**

Art Unit  
**2171**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Jan 29, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-66 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

DOV POPOVICI  
PRIMARY EXAMINER

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

*Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I: Claims 1 - 35 and 62-66, drawn to a method and apparatus for determining a relationship between first and second textual inputs of retrieving information, classified in Class 707, subclass 4.

Group II: Claims 36-40, 44, drawn to a method of generating an index corresponding to a first textual corpus, classified in Class 707, subclass 101.

Group III: Claims 45-51 and 57-61, drawn to a method of identifying a hierarchy threshold in a relation hierarchy corresponding to a textual input, classified in Class 707, subclass 102.

Group IV: Claims 52-56, drawn to a method of identifying case information corresponding to constituents in a textual input, classified in Class 707, subclass 3.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I, II, III, and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group I has separate utility such as input preparations by determining the relationship between textual inputs. Group II teaches a method of generating an index corresponding to a first textual corpus, Group III teaches identifying a hierarchy threshold in a relation hierarchy corresponding to a textual input, and

Group IV teaches a method of identifying case information corresponding to constituents in a textual input. See M.P.E.P. § 806.05(d).

3. The inventions are distinct, each from the each other because of the following reasons:

a. These inventions have acquired a separate status in the art as shown by the different classification

b. The search required for one Group is not required for the other group

For the reasons above restriction for examination purposes as indicated is proper.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy Pardo, whose telephone number is (703) 305-1091. The examiner can normally be reached Monday through Thursday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached at (703) 305-3830.

The fax phone number for the organization where this application or proceeding is assigned are as follows:

(703) 746-7238	(After Final Communication)
(703) 746-7239	(Official Communication)
(703) 746-7240	(For Status inquiries, draft communication)

and/or:

*(703) 746-5616 (Use this Fax#, only after approval by Examiner, for "INFORMAL" or "Draft" communication. Examiner may request that a formal/amendment be faxed directly to then on occasions).*

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

**2. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**Or:**

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Serial Number: 09/336,200  
Art Unit: 2175


Page 5

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA.,

Sixth Floor (Receptionist).



Thuy Pardo  
January 29, 2002



DOV POPOVICI  
PRIMARY EXAMINER